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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,139	10/09/2001	Paul W. Rockley	2730	4692

26822 7590 05/28/2003
WALTER A. HACKLER
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EXAMINER

DAVIS, DANIEL J

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 05/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/973,139

Applicant(s)

Examiner

D Jacob Davis

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-15 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-15 and 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

The specification is objected to because the first paragraph of the specification indicates that the present application is a continuation-in-part, yet neither the Oath nor the Transmittal Letter make reference to any other application.

Claims 6, 7, 13, 14, 20 and 21 are objected to because of the following informalities: the claims depend from canceled claims. It will be assumed in this Office action that claims 6 and 7 depend from claim 1, claims 13 and 14 depend from claim 8, and claims 20 and 21 depend from claim 15. Appropriate correction is required in response to this action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 6 and 7 recite the limitation "tip". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, 7, 8, 10, 11, 15, 17, 18, 19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Evvard et al. (US 3,736,938). Evvard discloses an apparatus in Fig. 1 for the phacoemulsification of lens tissue comprising a first instrument 20 including an ultrasonically vibrated needle 25 and a second instrument 23 and 24 having a port comprising the distal end of the second instrument.

The second instrument comprises a tool tip, i.e. the distal end of element 24, which is capable of being used to manipulate a cataract as the cataract is being removed. The shaft includes element 24. The tip and shaft are monolithic. Since the shaft 24 is used to deliver a fluid (Col. 2, lines 59-62), it inherently has a lumen. The second instrument also comprises a conduit 23. The very tip of the needle is a “blade.”

Claims 1, 3, 4, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Rainin (US 5,569,279). Rainin discloses an instrument for the removal of lens tissue (Figs. 1-3) comprising a first instrument 100, a second instrument 50 having a tool 12, and a port comprising the distal end of the second instrument. The second instrument comprises a conduit 46 attached a shaft 36. The tip of the second instrument is generally in the shape of a hook.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 12 and 19 are rejected under 35 U.S.C. 103(a) is unpatentable over Evvard in view of McCabe et al. (US 5,562,640). Evvard fails to disclose a plurality of irrigation ports in the irrigation instrument. Nevertheless, McCabe teaches the use of a generic endoscopic surgical instrument used in irrigating and aspirating a surgical site. The irrigation channel comprises a plurality of holes 44, which more efficiently irrigate a surgical site. Although the instrument is a generic surgical instrument and is silent regarding its application to cataract surgery, one of ordinary skill in the art of irrigating and aspirating would look to the generic surgical art to more efficiently irrigate during cataract surgery. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to alter the Evvard device as taught by McCabe to further comprise a plurality of holes in the irrigation instrument to irrigate more efficiently.

Claims 8-11, 13, 15, 17, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rainin in view of Evvard. Rainin is silent regarding the use of

ultrasonically vibrated to more efficiently break up the cataract. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply ultrasonic vibratory energy to the second instrument 50 to more efficiently break up a cataract.

Conclusion

Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to D Jacob Davis whose telephone number is (703) 305-1232. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on (703) 308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.


DJD

May 8, 2003



DAVID O. REIP
PRIMARY EXAMINER